IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of: David M. Allen

Application No.: 10/694,304 Confirmation No.: 3573

Filed: October 27, 2003 Art Unit: 3635

For: BASEBOARD ASSEMBLY AND TRIM Examiner: W. V. Gilbert

APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party in interest in this case is David M. Allen, Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 15 claims. Claims 14-15 have been canceled, and new claims 16-18 were added by amendment. Claims 1-13 and 16-18 are pending, rejected and under appeal. Claims 1, 16 and 17 are the independent claims.

IV. Status of Amendments

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a baseboard assembly installed in a junction region where a

lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising a base portion having a back surface and an opposed front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor, the upper end of the base portion being sloped downwardly from the front surface to the back surface; and a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion (specification, page 2, lines 3-15); wherein the base portion and top portion have dissimilar cross sections when taken perpendicular to the respective back surfaces (Figure 5).

Independent claim 16 is directed to a baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising a base portion having a back surface and an opposed front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor (specification, page 2, lines 3-9), substantially the entirety of the lower end of the base portion being generally flat and perpendicular to the back surface (Figure 5), the upper end of the base portion being sloped downwardly from the front surface to the back surface; and a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion. (Specification, page 2, lines 9-15).

Independent claim 17 is directed to a baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising a base portion having a back surface and an opposed generally parallel front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor (specification, page 2, lines 3-9), the lower end of the base portion being generally flat and perpendicular to the back surface (Figure 3), the upper end of the base portion being sloped downwardly from the front surface to the back surface;

and a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion. (Specification, page 2, lines 9-15).

VI. Grounds of Rejection To Be Reviewed On Appeal

A. The rejection of claims 1-11, 13, and 16-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,202,380 to Trutwin in view of U.S. Patent No. 1, 585,960 to Baum.

B. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,202,380 to Trutwin in view of U.S. Patent No. 6,189,276 to Pinto.

VII. Argument

A. The §103 Rejection of Claims 1-11, 13 and 16-18.

The present invention is directed to a baseboard assembly having a base portion and a top portion that interact to form an overall assembly. The base portion has a back surface that is positioned against a wall and an upper surface that is sloped. A top portion is then positioned above the base portion such that its sloped lower surface interacts with the sloped upper surface of the base portion and the top portion is retained in position. A key benefit of this invention is that the base portion may be positioned by placing it snugly against the wall and nailed into position. The wall above the base portion may then be painted prior to installation of the top portion. The top portion is then installed very simply by placing it above the bottom portion and pressing it snugly into position. It should be noted that the base portion is easily positionable since the back surface is placed in contact with the wall. As such, it installs without measuring or spacing it from the base of the wall. Also, the sloped engagement surfaces allow the top portion to fit to the base portion and adjust to the space available. Exact positioning is not critical to the fit.

The Trutwin reference is directed to solving a completely different problem, defining an electrical passage in a baseboard, and consequently has a different structure and function. Trutwin does not contemplate the painting-related benefits of a two piece baseboard and consequently does not

appreciate the corresponding benefit of a sloped interconnection. Unlike the present invention, the design in Trutwin would require a very precise positioning of the upper piece in order that it is received in the lower piece. Also, the Trutwin design would be substantially more difficult and expensive to manufacture, since the two pieces cannot be cut from a single piece of wood without substantial waste, and the size and positioning of various features would be critical to the function of the overall design.

As noted by the Examiner, Trutwin does not teach or suggest sloped surfaces, as in the present invention. The Examiner relies on the Baum reference to address this shortcoming. Applicant disagrees with this combination on several grounds.

Applicant recognizes that the recent KSR case takes a more expansive approach to determining obviousness, and that the Patent Office has put forth a number of rationales for establishing a Prima Facie case of obviousness. However, each rationale for obviousness still requires that the combination meet certain requirements, including a nexus between the factual findings and the conclusion of obviousness. It is not proper to use hindsight based on Applicant's disclosure to assemble the necessary elements from the prior art. "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautions of arguments reliant upon *ex post* reasoning." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1397 (2007) (citing *Graham*, 383 U.S. at 36).

The Examiner states that the substitution of part of Baum into Trutwin "would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of functional equivalence" July 22, 2008 Office Action page 3, lines 20-22) (emphasis added). This rationale appears to be based on the statement in KSR that "when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR* at 1395 (citing *United States v. Adams*, 383 US 39, 50-51 (1966).

Most new inventions, especially in the mechanical arts, may be seen as mere combinations of existing elements. However, such a view suggests that everything is obvious. Clearly, this is not the case. To establish obviousness, the court in KSR required that the modification of the prior art amount to a "mere substitution of one element for another" and that this mere substitution result in a "predictable result". Applicant respectfully submits that the combination put forth by the Examiner does not meet these requirements.

The Examiner's suggested combination is not a mere substitution. To qualify as a mere substitution, the element being substituted would necessarily have to be used in the same way as in the original reference, keeping in mind its function and context. The Baum baseboard design is intended to reduce the stack-up between shoe molding and baseboard by providing a beveled lower surface on the baseboard and nesting the shoe mold into this beveled area. As explained in the text of the Baum reference, the baseboard itself is installed first with the shoe mold 7 being installed thereafter. As shown clearly in Figure 2, the shoe mold is a very small beveled piece without a back surface that contacts the wall. As will be clear to those of skill in the art, the upper baseboard piece must be very accurately positioned so that the shoe mold 7 fits in the available space and functions as intended. When positioned as intended, the entire shoe mold is spaced from the wall, thereby leaving a gap. If Baum and Trutwin were to be combined by mere substitution, the combination would not provide the elements of the present invention. Trutwin, like many baseboard designs, would typically be used with shoe molding. If one of skill in the art were to combine Trutwin and Baum, the logical combination would be to cut off the bottom of the lower portion of Trutwin baseboard and use a nested shoe molding like the one shown in Baum, thereby eliminating a traditional shoe molding. Baum could be used with Trutwin, or even with the present invention, but such combined use would lead to elimination of a traditional shoe molding, not to providing sloped surfaces of upper and lower pieces as defined in the present invention.

Looked at another way, a combination of Trutwin and Baum does not result in a "predictable result" of having a sloped engagement between upper and lower portions as in the present invention. The "predictable result" would be to eliminate the shoe molding that would normally be used with Trutwin and to nest such a shoe mold into the bottom of Trutwin.

While the present invention is simple, the prior art does not show the combination of elements claimed. Further, the combination suggested by the Examiner does not amount to a mere substitution resulting in a predicatable result. Instead, it appears that the Examiner has used the teachings of the present invention to combine features from prior art.

The Examiner also appears to rely on the traditional "teaching, suggestion, motivation" or TSM rationale for the combination of Trutwin and Baum. The Examiner states that the combination would be obvious "because Trutwin discloses that the invention is not limited to the details of construction and

arrangement of components and is capable of other embodiments" (December 26, 2007 Office Action page 3, line 23 to page 4, line 3). Applicant submits that this boilerplate language is insufficient to suggest or motivate one of skill in the art to modify Trutwin in the specific way necessary to meet the present claim limitations or to provide the dissimilar function and benefits of the present invention. As discussed previously, even if Trutwin and Baum were to be combined, the combination would not provide the elements of the present invention. Trutwin, like many baseboard designs, would typically be used with shoe molding. If one of skill in the art were to combine Trutwin and Baum, the logical combination would be to cut off the bottom of the lower portion of Trutwin baseboard and us a nested shoe molding like the one shown in Baum, thereby eliminating a traditional shoe molding. Baum could be used with Trutwin, or even with the present invention, but such combined use would lead to elimination of a traditional shoe molding, not to providing sloped surfaces of upper and lower pieces as defined in the present invention.

For at least the above reasons, Applicant respectfully submits that each of the rejected claims is allowable over the cited references.

B. The §103 Rejection of Claim 12

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,202,380 to Trutwin in view of U.S. Patent No. 1,585,960 to Baum, and further in view of U.S. Patent No. 6,189,276 to Pinto. Applicant again respectfully disagrees. All of the above arguments apply to this rejection. In light of this, Applicant respectfully submits that claim 12 is in condition for allowance, along with all other pending claims.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: November 7, 2008

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APPENDIX A

CLAIMS ON APPEAL

1. A baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising:

a base portion having a back surface and an opposed front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor, the upper end of the base portion being sloped downwardly from the front surface to the back surface; and

a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion;

wherein the base portion and top portion have dissimilar cross sections when taken perpendicular to the respective back surfaces.

2. The baseboard assembly according to claim 1, wherein the base portion and the top portion are both elongated members such that the base portion extends along the wall adjacent the floor.

3. The baseboard assembly according to claim 2, wherein the base portion and the top portion both have the same length in the elongated direction

4. The baseboard assembly according to claim 1, wherein the baseboard assembly is installed at a generally vertical corner where the wall meets an adjoining wall, the base portion and the top portion each having a generally rectangular horizontal cross section

5. The baseboard assembly according to claim 1, wherein the upper end of the base portion comprises a sloped surface that forms an angle with the front surface of the base portion and the lower end of the top portion comprises a sloped surface that forms substantially the same angle with the back

surface of the top portion.

6. The baseboard assembly according to claim 5, wherein the angles are in the range of 30 to 60 degrees.

7. The baseboard assembly according to claim 5, wherein the angles are in the range of 40 to 50 degrees.

8. The baseboard assembly according to claim 5, wherein the angles are approximately 45 degrees.

9. The baseboard assembly according to claim 1, wherein the base portion and the top portion each have a thickness as measured between the respective back and front surfaces, the thicknesses being substantially the same.

10. The baseboard assembly according to claim 1, wherein the base portion and the top portion are formed from a single piece of wood such that the grain of the top portion generally matches the grain of the base portion.

11. The baseboard assembly according to claim 1, wherein the base portion has a recess formed where the back surface meets the upper end.

12. The baseboard assembly according to claim 1, wherein the top portion has a recess formed where the back surface meets the lower end.

13. A method of forming the baseboard assembly of claim 1, comprising the steps of:

providing an elongated board having a front surface and an opposed back surface;

cutting the board lengthwise at a non-perpendicular angle to the front surface such that the board forms the base portion and the top portion.

16. A baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising:

a base portion having a back surface and an opposed front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor, substantially the entirety of the lower end of the base portion being generally flat and perpendicular to the back surface, the upper end of the base portion being sloped downwardly from the front surface to the back surface; and

a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion.

17. A baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising:

a base portion having a back surface and an opposed generally parallel front surface, the base portion further having a lower end and an upper end, the base portion being installed position in the junction region with the back surface against the wall and the lower end adjacent the floor, the lower end of the base portion being generally flat and perpendicular to the back surface, the upper end of the base portion being sloped downwardly from the front surface to the back surface; and

a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion

18. A method of installing a baseboard assembly, comprising:

providing the baseboard assembly of claim 1;

installing the base portion in the junction region with the back surface against the wall and the lower end adjacent the floor; and

after installing the base portion, installing the top portion above the base portion with the back surface of the top portion against the wall and the sloped lower end of the top portion engaging the sloped upper end of the base portion.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.